

Appl. No. : 09/111,604
Filed : July 7, 1998

MASIMO.007C3

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Diab et al.
Appl. No. : 09/111,604
Filed : July 7, 1998
For : SIGNAL PROCESSING
APPARATUS
Examiner : Eric F. Winakur
Group Art Unit : 3768

**CERTIFICATE OF EFS WEB
TRANSMISSION**

I hereby certify that this correspondence, and any other attachment noted on the automated Acknowledgement Receipt, is being transmitted from within the Pacific Time zone to the Commissioner for Patents via the EFS Web server on:

10/28/2011

(Date)

/Jarom Kesler/

Jarom Kesler, Reg. No. 57,046

**REVISED SUPPLEMENTAL PETITION UNDER 37 C.F.R. §1.181 FOR CORRECTION
OF PATENT TERM EXTENSION**

Mail Stop Petitions

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. §§ 1.701(a)(1) and 1.701(c)(1)(i) and pursuant to 35 U.S.C. § 154(b), Applicants Diab et al. hereby Petition the Director under 37 C.F.R. § 1.181 to correct the patent term extension ("PTE") for U.S. Patent No. 7,962,190 ("the '190 patent"). See M.P.E.P. § 2720. This petition supersedes the original Petition (titled "Supplemental Petition") filed on June 13, 2011.

Background and Introduction

Pursuant to 35 U.S.C. § 135(a), on July 18, 2006, the Board of Patent Appeals and Interferences ("the Board") declared an interference between the Diab patent application (now the '190 patent at issue in this Petition) and U.S. Patent No. 5,645,060 to Yorkey. *Yorkey v. Diab*, Patent Interference No. 105,477 (JL) (Paper 1). On May 28, 2008 – after 681 days of delay – the Board entered judgment against Yorkey. *Id.* (Paper 99). Yorkey thereafter appealed the Board's decision to the United States Court of Appeals for the Federal Circuit ("the Federal Circuit"). On April 7, 2010 – after another 679 days of delay – the Federal Circuit affirmed the Board's judgment. *Yorkey*

Appl. No. : **09/111,604**
Filed : **July 7, 1998**

v. Diab, 605 F.3d 1297 (Fed. Cir. 2010). Thereafter, on May 17, 2010 – after an additional 40 days of delay – the PTO received the Federal Circuit’s mandate affirming the Board. Accordingly, Yorkey’s unsuccessful Federal Circuit appeal resulted in an *additional* 715 days of delay (*viz.*, 679 days + 40 days = 719 days).

On May 25, 2011, the PTO mailed the Notice of Allowance with a PTE under 35 U.S.C. § 154(b) of only 681 days, limiting the PTE calculation to *only* the delay caused by the interference proceedings before the Board. On June 14, 2011, the PTO then issued the ‘190 patent, again with PTE under 35 U.S.C. § 154(b) of only 681 days. The PTO’s calculation of PTE entirely ignored the additional lengthy 719-day delay caused by Yorkey’s unsuccessful appeal of the Board’s judgment to the Federal Circuit. Indeed, the entire delay in issuance of the ‘190 patent due to the entirety of the interference proceeding (both before the Board and the Federal Circuit) was at least 1400 days (*viz.*, 681 days + 719 days = 1400 days). Importantly here, for purposes of calculating PTE, the interference proceedings terminated only *after* the Federal Circuit rendered its decision and the PTO received the Federal Circuit’s mandate. See former 35 U.S.C. § 154(b); 37 C.F.R. § 1.701; Rules and Regulations, 60 Fed. Reg. 20,204 (Apr. 25, 1995). Accordingly, Diab respectfully requests that the Director correct the PTE for the ‘190 patent to 1400 days in order to more accurately account for the delay caused by the interference proceedings.

Diab is Entitled to at Least an Additional 719 Days of Patent Term Extension for Delay Due to the Federal Circuit Appeal

Diab filed his patent application on July 7, 1998. Accordingly, because that application filing date is between June 8, 1995, and May 28, 2000, former 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701 apply here. See M.P.E.P. § 2720. In explaining a patent applicant’s entitlement to PTE, former Section 154(b) provides, in relevant part:

(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.- If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title . . . the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

35 U.S.C. § 154(b) (1999); *accord* M.P.E.P. § 2720.

Appl. No. : 09/111,604
Filed : July 7, 1998

Similarly, Section 1.701 provides, in relevant part:

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference proceedings under 35 U.S.C. 135(a);

* * *

(c)

(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference **and ending on the date that the interference was terminated** with respect to the application;

37 C.F.R. § 1.701 (emphases added).

Thus, Diab is entitled to PTE for any delay due to interference proceedings, and the amount of delay begins on the date the interference was declared and ends on the date that the interference was “terminated.” The Federal Register provides further guidance for determining when an interference proceeding is “terminated.” When a party appeals the Board’s interference judgment to the Federal Circuit, that appeal is part of the “interference proceeding” (within the meaning former 35 U.S.C. § 154(b) of 37 C.F.R. § 1.701), and that proceeding is “terminated” only *after* the Federal Circuit renders a decision and its mandate is received by the PTO:

An interference is considered terminated as of the date the time for filing an appeal under 35 U.S.C. 141 or civil action under 35 U.S.C. 146 expired. If an appeal under 35 U.S.C. 141 is taken to the Court of Appeals for the Federal Circuit, **the interference terminates on the date of receipt of the court’s mandate by the PTO.**

Rules and Regulations, 60 Fed. Reg. 20,204 (Apr. 25, 1995) (emphasis added).*

Accordingly, former 35 U.S.C. § 154(b), and 37 C.F.R. § 1.701, as explained in the Federal Register, collectively provide that delay caused by a Federal Circuit appeal

* Attached herewith as Exhibit 1.

Appl. No. : 09/111,604
Filed : July 7, 1998

of an interference judgment is to be included in the PTE calculation, and the delay continues until the PTO receives the mandate from the Federal Circuit.

As set forth above, in this case the interference proceeding began when the Board declared Interference No. 105,477 on July 18, 2006. Further, the interference proceeding terminated when the PTO received the Federal Circuit's mandate on May 17, 2010. Thus the total delay caused by the interference proceeding was 1400 days. This total delay includes: (1) the initial 681 days of delay from the declaration of the interference until the Board's judgment; and (2) the subsequent additional 719 days of delay from the Board's judgment until the PTO's receipt of the Federal Circuit's mandate following the appeal.

The '190 patent states that it has been accorded only 681 days of PTE, which is solely the delay caused by the portion of the interference proceeding when pending before the Board. The '190 patent does **not** include any of the additional 719 days of delay caused by Yorkey's unsuccessful appeal of the Board's interference judgment to the Federal Circuit. As such, the PTE for the '190 patent should be corrected to include at least those additional 719 days of the portion of the interference proceeding before the Federal Circuit, resulting in a total PTE of 1400 days for the entire interference proceeding.

Conclusion

As set forth above, Diab submits that the PTE for the '190 patent should reflect the cumulative total of **1400 days** of delay due to interference proceeding both before the Board and before the Federal Circuit, not simply the 681 days of delay as currently indicated on the patent's cover page. Diab therefore respectfully requests that the Director correct the PTE for the '190 patent to reflect at least the 1400 total days of delay.

No fee is deemed due under 37 C.F.R § 1.181 because neither 37 C.F.R. § 1.181 nor 37 C.F.R. §1.701 indicate that a fee is due in conjunction with a Petition under 37 C.F.R §1.181. However, in the event that a fee is due, please charge any ad-

//

//

Appl. No. : **09/111,604**
Filed : **July 7, 1998**

ditional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 28, 2011

By: /Jarom Kesler/
Jarom Kesler
Registration No. 57,046
Attorney of Record
Customer No. 20,995
(949) 721-2923

12175838

EXHIBIT A

Sections 1.177, 1.312(b), 1.313(a), and 1.314 are being amended to replace the references to § 1.17(i)(1) with references to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.316(d) is being amended to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.316(b) not filed within six (6) months of the date of the abandonment of the application. Acceptance of a late payment of an issue fee in a design application is specifically provided for in § 1.155. Therefore, § 1.316 does not apply to design applications. The language "filed before June 8, 1955" as used in the amended rule, refers to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121 or 365.

Section 1.317(d) is being removed and reserved to eliminate the requirement that a terminal disclaimer accompany any petition under § 1.317(b) not filed within six (6) months of the date of lapse of the patent.

Section 1.666 is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.701 is being added to set forth the procedure the PTO will follow in calculating the length of any extension of patent term to which an applicant is entitled under 35 U.S.C. 154(b) where the issuance of a patent on an application, other than for designs, filed on or after June 8, 1995, was delayed due to certain causes of prosecution delay. Applicants need not file a request for the extension of patent term under § 1.701. The extension of patent term is automatic by operation of law. It is currently anticipated that applicant will be advised as to the length of any patent term extension at the time of receiving the Notice of Allowance and Issue Fee Due. Review of the length of a patent term extension calculated by the PTO under § 1.701 prior to the issuance of the patent would be by way of petition under § 1.181. If an error is noted after the patent issues, patentee and any third party may seek correction of the period of patent term granted by filing a request for Certificate of Correction pursuant to § 1.322. The PTO intends to identify the length of any patent term extension calculated under § 1.701 on the printed patent.

Section 1.701(a) is being added to identify those patents which are entitled to an extension of patent term under 35 U.S.C. 154(b).

Section 1.701(b) is being added to provide that the term of a patent entitled

to extension under § 1.701(a) shall be extended for the sum of the periods of delay calculated under §§ 1.701 (c)(1), (c)(2), (c)(3) and (d), to the extent that those periods are not overlapping, up to a maximum of five years. The section also provides that the extension will run from the expiration date of the patent.

Section 1.701(c)(1) is being added to set forth the method for calculating the period of delay where the delay was a result of an interference proceeding under 35 U.S.C. 135(a). The period of delay with respect to each interference in which the application was involved is calculated under § 1.701(c)(1)(i) to include the number of days in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application. An interference is considered terminated as of the date the time for filing an appeal under 35 U.S.C. 141 or civil action under 35 U.S.C. 146 expired. If an appeal under 35 U.S.C. 141 is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the PTO. If a civil action is filed under 35 U.S.C. 146, and the decision of the district court is not appealed, the interference terminates on the date the time for filing an appeal from the court's decision expires. See section 2361 of the MPEP. The period of delay with respect to an application suspended by the PTO due to interference proceedings under 35 U.S.C. 135(a) not involving the application is calculated under § 1.701(c)(1)(ii) to include the number of days in the period beginning on the date prosecution in the application is suspended due to interference proceedings not involving the application and ending on the date of the termination of the suspension. The period of delay under § 1.701(a)(1) is the sum of the periods calculated under §§ 1.701 (c)(1)(i) and (c)(1)(ii), to the extent that the periods are not overlapping.

Section 1.701(c)(2) is being added to set forth the method for calculating the period of delay where the delay was a result of the application being placed under a secrecy order.

Section 1.701(c)(3) is being added to set forth the method for calculating the period of delay where the delay was a result of appellate review. The period of delay is calculated under § 1.701(c)(3) to include the number of days in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed

under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

Section 1.701(d) is being added to set forth the method for calculating any reduction in the period calculated under § 1.701(c)(3). As required by 35 U.S.C. 154(b)(3)(B), § 1.701(d)(1) provides that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination. The "filing date" for the purpose of § 1.701(d)(1) would be the earliest effective U.S. filing date, but not including the filing date of a provisional application or the international filing date of a PCT application. For PCT applications entering the national stage, the PTO will consider the "filing date" for the purpose of § 1.701(d)(1) to be the date on which applicant has complied with the requirements of § 1.494(b), or § 1.495(b), if applicable.

As contained in Public Law 103-465, 35 U.S.C. 154(b)(3)(C) states that the period of extension referred to in 35 U.S.C. 154(b)(2) "shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner." Section 1.701(d)(2) is being added to provide that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. Section 1.701(d)(2) also provide that in determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review. Acts which the Commissioner considers to constitute *prima facie* evidence of lack of due diligence under § 1.701(d)(2) are suspension at applicant's request under § 1.103(a) during the period of appellate review and abandonment during the period of appellate review.

Section 3.21 is being amended to provide that an assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number,